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EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,621

Applicant(s)

HIRI ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-19 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 09/15/05. Claims 1-7, 9-19 and 21-35 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-7, 9-19 and 21-35 have been fully considered but they are not persuasive.

Regarding claim 1, the Applicant argues on page 9, lines 28-31 that 'the examiner fails to point any teaching in Gregorek where a user of a called party device causes the sending of a message to a first calling party device using an input mechanism associated with said called party device'. The examiner disagrees with this argument. It is because, Gregorek teaches that after the called party places the first calling party on hold, the first calling party will receive voice announcements until the second telephone 20 reconnects to the first telephone 12. It is clear that placing the first telephone on hold is caused by the input mechanism of second telephone and such action causes the first telephone receiving audio announcements (col.16, lines 20-45). Thus, Gregorek does teach the claimed limitation "the called party causes the sending of a message to a first calling party device using an input mechanism associated with said called party device". Thus the rejection of the claim in view of Gregorek remain.

The Applicant further argues on page 10, lines 15-18 that 'That assertion by the Examiner as to what Gregorek teaches, however, appears to contradict later statement (page 3, 4th paragraph) that Gregorek "does not specifically teach 'the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of

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predefined messages’.” The examiner disagrees with this argument. Gregorek discloses that a message generator determines type of messages to be played based on the subscriber input or menu selection (see col.19, line 55- col.20, line 10). However, Gregorek does not specifically disclose an announcement comprising a user’s selected predefined message. The Applicant further argues on page 11, lines 17-20 that ‘Casellini teaches away from the use of a common device for both call connections and simultaneous messaging to calling parties in the manner claimed by Applicants’. The examiner disagrees with this argument. Examiner did not rely upon Casellilni for the teaching of the use of a common device for both call connections and simultaneous messaging to calling parties. Examiner relied upon Casellilni for the teaching of user’s selecting a message [i.e., one of a plurality of predefined messages] (fig.4A-6; col.5, lines 6-20). Thus the rejection of the claim in view of Gregorek and Casellilni remain.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1-4, 6, 7, 9, 10, 13-16, 18, 19, 21, 22, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) in view of Casellini (U.S. Patent No. 6,404,860).

Regarding claims 1 and 13, Gregorek teaches establishing a first call link between the called party device and a first calling party device (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4).

Gregorek further teaches receiving a call request to the called party from a second calling party (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56).

Gregorek further teaches placing the first call link on hold (abstract; col.4, lines 4-8, col.15, lines 32-56, col.16, lines 20-45).

Gregorek further teaches accepting the call request from the second calling party device to establish a second call link between the called party device and the second calling party device

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(abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45).

Gregorek further teaches causing, through signaling the switch 22 [i.e., selective activation] by the user of the called party device, an announcement to the first calling party device, the step of causing an announcement to the first calling party device comprising one of a plurality of customized announcements [i.e., predefined messages] using an input mechanism associated with the called party device while the called party is in communication with the second calling party, whereby the user of the called party device can communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45, col.19, line 53-col.20, line 14; ‘announcement’ reads on the claim ‘message to be transmitted’).

However, Gregorek does not specifically teach “the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages”. Casellini teaches the step of causing an announcement to the first calling party device comprising the step of the user selecting a message [i.e., one of a plurality of predefined messages] (fig.4A-6; col.3, lines 64-67, col.4, lines 1, 2, 14-27, 42-67, col.5, lines 1-22, 25-40). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages as taught by Casellini. The motivation for the modification is to have doing so in order to give the caller a personal message from a called party.

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Regarding claims 2, 14 and 26, Gregorek teaches the message instructing the user of the first calling party device to hold (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45).

Regarding claims 3, 15 and 27, Gregorek teaches the message instructing the user of the first calling party device that the call link to the called party device will be disconnected (abstract; col.3, lines 61-67, col.4, lines 1-29, col.16, lines 20-45).

Regarding claims 4, 16 and 28, Gregorek teaches the message automatically causing the first call link to be terminated (fig.3; col.4, lines 1-29, col.11, lines 60-67, col.12, lines 1-5, col.15, lines 32-56, col.16, lines 20-45).

Regarding claims 6, 18 and 30, Gregorek teaches that the first calling party device to be connected to a message generator associated with the user of the called party device (col.4, lines 1-29, col.9, lines 46-54, col.15, lines 32-56, col.16, lines 20-45; 'message generator' reads on the claim 'messaging system').

Regarding claims 7, 19 and 31, Gregorek teaches the message comprising a prerecorded voice message (col.11, lines 16-31, col.15, lines 32-56, col.16, lines 20-45).

Regarding claims 9, 21 and 32, Gregorek fails to teach "generating a text message using an input mechanism associated with said called party device". Casellini teaches generating a text message using an input mechanism associated with the called party device (abstract; fig.6; col.4, line 41-col.5, line 40). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow generating a text message using an input mechanism as taught by Casellini. The motivation for the modification is to have the generation in order to provide transmitted characters which make up the body of a message.

Regarding claims 10, 22 and 33, Gregorek fails to teach “converting said text message to speech”. Casellini teaches converting the text message to speech (col.5, lines 17-21). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow converting the text message to speech as taught by Casellini. The motivation for the modification is to have the conversion in order to produce audio message for the caller.

Regarding claim 25 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Gregorek teaches a first calling party station [i.e., first remote telephony device] (abstract; col.3, lines 61-67, col.4, lines 1-29).

7. Claims 5, 17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) in view of Casellini (U.S. Patent No. 6,404,860) further in view of Rogers et al. (U.S. Patent No. 5,946,386).

Regarding claims 5, 17 and 29, Gregorek in view of Casellini does not specifically teach “said message instructs said user of said first calling party device to leave a message”. Rogers teaches that the message instructs the first calling party device to leave a message (col.13, lines 40-44). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek in view of Casellini to allow message instructing the user of the first calling party device to leave a message as taught by Rogers. The motivation for the modification is to have doing so in order to store the message for the later retrieval.

8. Claims 11, 23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) in view of Casellini (U.S. Patent No. 6,404,860) further in view of Tatchell et al. (U.S. Patent No. 6,160,877).

Regarding claims 11, 23 and 34, Gregorek in view of Casellini does not specifically teach “call links between said called party device and said calling party devices are established through a packet-switched communications network”. Tatchell teaches that the signaling link is established through a packet switched network (col.6, lines 51-60; ‘signaling link’ reads on the claim ‘call links between said called party device and said calling party devices’ and ‘packet switched network’ reads on the claim ‘packet-switched communications network’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek in view of Casellini to allow call links be established through a packet-switched communications network as taught by Tatchell. The motivation for the modification is to have the packet-switched communications network in order to carry data in the form of packets.

9. Claims 12, 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) in view of Casellini (U.S. Patent No. 6,404,860) further in view of Tatchell et al. (U.S. Patent No. 6,160,877) further in view of Zhakov et al. (U.S. Pub. No. 2003/0021264).

Regarding claims 12, 24 and 35, Gregorek in view of Casellini further in view of Tatchell fails to teach “call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)”. Zhakov teaches that call links are established using a Session Initiation Protocol (SIP) (page no.3, paragraphs 0034-0035; ‘Session Initiation Protocol (SIP)’ reads on the claim ‘an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek in view of Casellini further in view of Tatchell to allow call links be

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established using a Session Initiation Protocol (SIP) as taught by Zhakov. The motivation for the modification is to have the Session Initiation Protocol for creating, modifying and terminating communication sessions with one or more participants.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE
November 18, 2005

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante